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FROM: MATTHEW C. LOPPNOW (847) 523-2585
(SENDER'S NAME) (EXTENSION)

RE: APPLICATION NO. 10/693,248


TOTAL NUMBER OF PAGE(S) 6 (INCLUDING THIS PAGE)

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Signature  Date July 24, 2006
Matthew C. Loppnow

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: GORDECKI

EXAMINER: Gelin, J.

SERIAL NO.: 10/693,248

GROUP: 2617

FILED: October 24, 2003

CASE NO.: CS22815RL

ENTITLED: CELLUAR TELEPHONE WITH IMPROVED MECHANICAL DESIGN

Motorola, Inc.
Intellectual Property Department
600 North U.S. Highway 45
Libertyville, IL 60048

PETITION UNDER 37 C.F.R. § 1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Jurisdiction

The Commissioner has jurisdiction to consider the issues discussed below under 37 C.F.R. § 1.181.

Issue

At issue is whether the June 12, 2006 Advisory Action improperly maintains the finality of the January 30, 2006 Office Action. The more narrow issue is whether the finality

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of the January 30, 2006 Office Action is improper because it cites a new ground of rejection against an unamended claim.

Overview of Procedural History

Original dependent claim 11 was originally directly dependent from original independent claim 1.

On November 20, 2005, Applicant filed an Amendment that added claim 20 to recite claim 11 in independent form by combining it with claim 1. In particular, claim 1 was originally pending as follows:

1. A cellular telephone comprising:
a first part having a longitudinal axis, the first part including a display;
a second part coupled to the first part by a pivot mechanism that includes a pivot axis that makes an angle of less than ninety degrees with the longitudinal axis of the first part, whereby the second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part.

Claim 11 was originally pending as follows:

11. The cellular telephone according to claim 1 wherein:
the second part comprises a first surface and a second surface;
the pivot axis is tilted with respect to the longitudinal axis by an angle of alpha;
and
the first surface and the second surface are tilted in opposite directions with respect to the pivot axis by the angle alpha.

Claim 20 was added as follows:

20. A cellular telephone comprising:
a first part having a longitudinal axis, the first part including a display; and
a second part coupled to the first part by a pivot mechanism that includes a pivot axis that makes an angle of less than ninety degrees with the longitudinal axis of the first

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part, whereby the second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part,

wherein

the second part comprises a first surface and a second surface;

the pivot axis is tilted with respect to the longitudinal axis by an angle of alpha;

and

the first surface and the second surface are tilted in opposite directions with respect to the pivot axis by the angle alpha.

After Applicant's Amendment, a January 30, 2006 Office Action was issued that applied a new ground of rejection against claim 20. However, the Office Action was made final without explanation. In particular, the only indication of finality was a check in box 2a) of the Office Action summary. In fact, the Detailed Action did not even mention the finality, much less provide an explanation. The Detailed Action only made a brief mention of a new ground of rejection in the "Response to Arguments" section. However, this section still did not explain the finality of the Office Action.

In response, Applicant traversed the finality of the Office Action in a May 7, 2006 Response After Final Rejection. In particular, Applicant pointed out a new ground of rejection was made against an unamended claim and thus, the finality was improper.

After Applicant's Response After Final Rejection, a June 12, 2006 Advisory Action was issued which maintained the finality of the Office Action.

Applicant's now petition the Commissioner for relief.

Summary of Rejection Asserted By Applicants to Raise New Grounds of Rejection of Claim 20

The January 30, 2006 Office Action applied a new ground of rejection, as admitted by the Office Action in the "Response to Arguments" section. In particular, claim 20, which is original claim 11 in independent form, was rejected under 35 U.S.C. 102(e) over Matsumoto (U.S. Patent Pub. No. 2003/0228847).

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Applicant's Assertion

Applicant traverses the finality of the Office Action because it introduced a new ground of rejection that was not necessitated by Applicant's amendment. In particular, MPEP § 706.07(a) expressly states "...Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims..." The final Office Action introduced a new ground of rejection of claim 20. However, claim 20 already existed as claim 11 at the time of the first Office Action. More particularly, claim 20 is the verbatim recitation of original claim 11 in independent form, as clearly indicated on page 6 of the original Amendment.

To elaborate, claim 11 was originally rejected over Wilk (U.S. Patent No. 6,643,124). Claim 20 is now rejected over Matsumoto (U.S. Patent Pub. No. 2003/0228847), which is a new ground of rejection. Because no amendments were made to claim 11 when it was rewritten in independent form as claim 20, the new ground of rejection was not necessitated by Applicant's amendment, as required by MPEP § 706.07(a). Accordingly, Applicant requests the withdrawal of the finality of the Office Action.

The Advisory Action Allegation

The Advisory Action alleges, "The Applicant further argues that no amendment were made over to claim 11 when it was rewritten in independent claim 20. However, the Examiner disagrees with the preceding limitation. Claim 11 was dependent on claim 1 which includes a camera but claim 20 does not include the camera. Therefore, the final rejection is maintained.

Applicant's Response

Applicant asserts the Advisory Action mischaracterizes the prosecution history to maintain the finality of the Office Action. In particular, the Advisory Action alleges finality is proper because claim 1 includes a camera and claim 20 does not include the camera. However, original claim 1 did not include a camera. More particularly, claim 20 is the recitation of unamended claim 11 in independent form. Claim 11 was dependent on original

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claim 1 and original claim 1 did not include a camera. As clearly illustrated above in the presentation of original claim 1, original claim 11, and new claim 20, claim 11 was not amended when rewritten as new claim 20. Because no features were added or removed from claim 11 when it was rewritten as claim 20, a subsequent Office Action cannot be made final if it applies a new ground of rejection to the unamended claim. Effectively, claim 20 was already pending as claim 11. Thus, the Office Action cannot be made final because it introduces a new ground of rejection against unamended original claim 11 rewritten in independent form as claim 20.


Accordingly, the finality of the January 30, 2006 Office Action's is improper because it cites a new ground that was not necessitated by amendment by using Matsumoto to reject claim 20, which is original claim 11 rewritten in independent form.

Prayer for Relief

Kindly remand the instant application to the Examiner with instructions to withdraw the finality of the January 30, 2006 Office Action.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



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Dated: July 24, 2006

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